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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,801	06/05/2001	Peter Simonelli	231.301	5916

7590 09/03/2002

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EXAMINER

YIP, WINNIE S

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 09/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/874,801

Applicant(s)

SIMONELLI ET AL.

Examiner

Winnie Yip

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 8-13 and 19-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 14-18 and 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

This is a first office action for application Serial No. 09/874,801 filed June 5, 2001.

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

- a. Group I, a first embodiment, shown in Figs. 2-3;
- b. Group II, a second embodiment, shown in Figs. 4-7.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mr. Lindsay on August 13, 2002, a provisional election was made with traverse to prosecute the invention of Group II, claims 1-7, 14-18, and 24-27. Applicant in replying to this Office action must make affirmation of this election. Claims 8-13 and 19-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features “the wood boards are placed in the wood subfloor with the coated side face up” (claim 7) and “the moisture and condensation barrier is above the wood subfloor” (claim 13) must be shown or the features canceled from the claims. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1, 4-6, 14-15, 17-18, 24-25, 27 are rejected under 35 U.S.C. 102(b) as being anticipated Nemeth (US Patent No. 4,242,390).

Nemeth show and teaches a flooring system comprising wood subfloors (26 or 41, 41'), wood finished floors (17) , a moisture and condensation barrier layer (28, 20, 30) made of a liquid rubberized coating material such as thermoplastics (see col. 7, lines 13-14 and lines 38-43) is selectively coated on a bottom and sides of the wood subfloors, the coated subfloors being placed onto the concrete slab to form a wood subfloor with a moisture protection, wherein, after the coating material (28, 20, 30) is cured into a solid after being coated onto the wood subfloor, the barrier layer inherently has a thickness sufficiently preventing moisture and condensation from penetrating.

3. Claims 24-25 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated Japanese Patent No. 7-268970.

The Japanese reference teaches a flooring system comprising wood boards (2), a moisture and condensation barrier layer (3, 7, 9) made of a liquid rubberized coating being coated on a lower and/or a bottom surface of the wood boards, and the barrier layer being cured into a solid

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station after being coated onto the wood board to provide a prescribed thickness sufficiently preventing moisture and condensation from penetrating (see ABSTRACT).

4. Claims 24-25, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Padmanabhan (US Patent No. 6,179,942) .

Padmanabhan show and teaches a flooring system comprising wood boards (28), a moisture and condensation barrier layer (17) made of a liquid rubberized coating material being coated onto a lower surface of the wood board, and the barrier layer (17) inherently having a thickness for sufficiently preventing moisture and condensation from penetrating, wherein the liquid rubberized coating material conventionally cured into a solid after being coated onto the wood board.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7, 14-18, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mauran (US Patent No. 895,651) in view of Abendroth et al. (US Patent No.4,910,936) and Nemeth '390.

Mauran show and teaches a flooring system comprising a wood subfloor having a plurality of wood boards (4) disposed on a concrete slab (6), a moisture and condensation barrier layer (5) disposed on the a lower surface of the wood boards, and the barrier inherently having a

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thickness for sufficiently preventing moisture and condensation from penetrating, and a radian heating system including pipes (7) supported by the concrete slab and disposed under the wood subfloors (4) and the moisture and condensation barrier layer (5). Although Mauran does not define the flooring system further having a wood finished floor disposed on the wood subfloor, however, Abendroth et al. teach a flooring system, as a common practice, comprising wood finished floor secured on an upper surface of a wood subfloor supported on a concrete slab for providing a finished surface with selected appearance. It would have been obvious to one of ordinary skill in the art at the time the invention made to modify the flooring system of Mauran provided a wood finished floor disposed on the wood subfloor as taught by Abendroth et al. as old and well known practice for providing a stronger flooring surface with desirable appearance for variety of applications. Further, Mauran and Abendroth et al. do not define the moisture and condensation barrier layer made of a liquid rubberized coating material to be coated onto the wood subfloor as claimed. Nemeth teaches a floor system comprising a moisture and condensation barrier layer (28) made of rubberized coating material which would be a sheet material or a coating layer to be coated onto a wood board for provide a wood subfloor. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the flooring system of Mauran having the moisture and condensation barrier layer being made of rubberized coating material to be coated to the under surface of the wood subfloor as taught by Nemeth as an obvious methods of design choice for reducing the steps of installation as desired.

In regard to claims 2 and 26, although Mauran does not define the moisture and condensation barrier layer having a particular thickness as claimed, Abendroth et al. further

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teach the flooring system comprising the moisture and condensation barrier layer having a thickness about 6 mil. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the moisture and condensation barrier layers of the flooring systems of Mauran having very dimensions of the thickness of as taught by Abendroth et al. as a matter of obvious design choice for providing with suitable thickness for sufficiently preventing moisture and condensation penetrating the barrier layer to accommodate the specialized flooring requirements.

7. Claims 2 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemeth '390, or Japanese Patent No.7-268970, or Padmanabhan '942 as applied to claims 1 and 24 above, and further in view of Abendroth (US Patent No. 4,910,936) for the same reasons set forth above rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Abendroth '342, Counihan '590, Tank '800, Schneider '720, and German Patent No. 195,20,567 teach various flooring system having a moisture and condensation barrier layer as similar to the claimed invention.

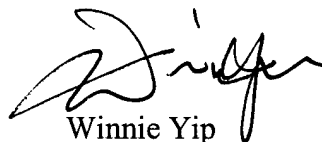
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Yip whose telephone number is (703) 308-2491. The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai, can be reached on (703) 308-2486.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is **(703) 308-1113**.

The Fax phone numbers for this Group where the application or processing is assigned are **(703) 872-9326** for regular communications and **(703) 872-9327** for After Final communications. The Fax phone number for Customer Service for this Group is **(703) 872-9325**.



Winnie Yip
Patent Examiner
Group Art Unit 3637

wsy

August 23, 2002